

REMARKS/ARGUMENTS

Claim Status

Claims 1-4, 7, 8 and 11 are pending. Claims 1, 2 and 8 are currently amended. Claims 5, 6, 9 and 10 are canceled without prejudice. Claim 1 is amended to include components (C), (D) and (G) which finds support in claims 5, 6, 9 and 10, as well as the specification: [0025], [0026], [0034], [0035] and Example 6 of Table 1. Claim 2 is amended to recite a Markush group of potential copolymers and finds support in the specification: [0024] and Examples 1-8 of Table 1. Claim 8 is amended to change “monomer” to “compound.” No new matter has been entered.

§112 Rejections

Claims 2 and 8 have been rejected because (a) the specification supports only rubber modified styrene or rubber non-modified styrene, not all “rubber polymers”, and (b) referring to the alkali and alkaline metal salts as “monomers” appears to be a misnomer as these compounds do not undergo polymerization, respectively. It is believed that these rejections have been obviated in view of (a) the replacement of “rubber polymers” with a specific Markush group as mentioned above, and (b) the removal of the word “monomer” and the replacement of the word “compound”. Accordingly, Applicants request the withdrawal of these rejections.

§103(a) Rejections

Claims 1-3, 5, 6 and 11 are rejected under 35 U.S.C. §102(a) as obvious in view of the combination of *Laughner '154* (US 5,369,154) and *Meyer* (US 2004/0030090). Claim 4 is rejected under 35 U.S.C. §102(a) as obvious in view of the combination of *Laughner '154* (US 5,369,154), *Meyer* (US 2004/0030090) and *Paul* (US 4,569,970). Claims 7-10 are

rejected under 35 U.S.C. §102(a) as obvious in view of the combination of *Laughner '154* (US 5,369,154), *Meyer* (US 2004/0030090) and *Laughner '686* (US 4,786,686). Applicants respectfully traverse these rejections.

The Office asserts that the claimed polycarbonate resin composition is rendered obvious by varying combinations of the cited references due to the fact that all of the components of the claimed resin are taught when the references are taken in combination.

Not notwithstanding the above, Applicants submit that (i) none of the cited references expressly disclose the claimed *combination* of components of the polycarbonate resin composition, and (ii) the claimed *combination* of components exhibits an improved balance of fluidity, rigidity, heat resistance and impact resistance, while maintaining flame retardance. Furthermore, in accordance with MPEP 2145:

“If a *prima facie* case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the *prima facie* case. See, e.g., *In re Dillon*, 919 F.2d 688, 692, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990). Rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995), by counsel, *In re Chu*, 66 F.3d 292, 299, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995), or by way of an affidavit or declaration under 37 CFR 1.132, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687; *In re Piasecki*, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984).” (emphasis added)

the Declaration of Mr. Mitsuhashi (submitted herewith) asserts that the impact resistance and flame retardance of the claimed invention is “unexpected.”

The Mitsuhashi Declaration explains that polycarbonate resin compositions falling both inside and outside the scope of Applicants’ claim 1 were prepared and evaluated in accordance with paragraphs [0038], [0039] and [0041]-[0043] of the original specification. Table A from the Declaration is reproduced below for ease of discussion and includes newly presented Example A and Comparative Examples A-D, as well as a reproduction of Example 6 from the original specification.

Table A

Components admixed (parts by mass)	Example A	Comparative Example		Example 6	Comparative Example	
		A	B		C	D
(A) PC-2 (A-2)				35	35	35
PC-3 (A-1)	75	75	75	50	50	50
(B) AS-1	15	15	15	15	15	15
(C) Talc	10	0.5	25	10	0.5	25
(D) Elastomer-1	5	0.5	20			
Elastomer-2				5	0.5	20
(G) PTFE	0.5	0.05	5	0.5	0.05	5
SFL (260°C, 2 mm thick) (cm)	39	43	35	42	44	36
Izod impact strength (kJ/cm ²)	35	5	15	40	6	15
HDT (load: 1.83 MPa) (°C)	117	115	113	116	118	112
Flexural strength (MPa)	92	90	87	92	93	87
Flexural modulus (MPa)	3500	2400	5000	3500	2300	4800
Flame retardance (UL94, 1.5 mm thick)	Not-V	Not-V	Not-V	V-0	Not-V	Not-V
LOI	23	22	22	41	26	27

As can be seen from the data above, and described in the Declaration, when the polycarbonate resin compositions fall within the scope of claim 1 (i.e., Examples A and 6), the obtained molded articles have excellent flame retardance and impact resistance. However, when the polycarbonate resin compositions fall outside the scope of claim 1 (i.e., Comparative Examples A-D), the obtained molded articles have inferior flame retardance and impact resistance. Furthermore, Mr. Mitsuhashi (a 19+ year polymer chemistry researcher, specifically polycarbonates) declares “This difference in impact resistance and flame retardance is unexpected, and constitutes objective evidence of the improvements of the polycarbonate resin composition of claim 1 over known resin compositions, as in Meyer et al., Laughner, Paul et al. and Laughner et al.” (emphasis added).

Accordingly, as Applicants have provided rebuttal evidence by way of a Declaration to the alleged *prima facie* case of obviousness in accordance with MPEP 2145, Applicants submit that the claimed invention is non-obvious in view of any combination of *Meyer*, *Laughner '154*, *Paul* and *Laughner '686*.

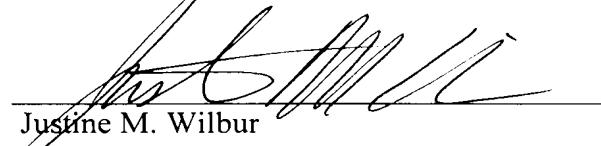
Thus, Applicants request withdrawal of the obviousness rejections.

Conclusion

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

Respectfully submitted,

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